

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/091,602	04/19/99	BUNGER	J BEIERSDÖRF50

HM12/0501
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EXAMINER
TRAVERS, R

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 05/01/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/091,602

Applicant(s)
Benger et al

Examiner
RUSSELL TRAVERS

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1617



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 31, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 20) ☐ Other:

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The amendment filed January 31, 2001 has been received and entered into the file.

Applicant's arguments filed January 31, 2001 have been fully considered but they are not deemed to be persuasive.

Claims 2-9 are presented for examination.

Applicant's election with traverse of a specific bacteria in Paper No. 9 is acknowledged. The traversal is on the ground(s) that Applicants must the prosecution before a proper election can be made. This is not found persuasive because an election is required to proceed with examination on the merits. Additionally, once an action on the merits has been entered, inventive subject matter under examination is fixed.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude

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patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 2-9 are rejected under 35 U.S.C. § 103 as being unpatentable over Matsumura et al, Shoji et al, and Ikekawa et al, in view of Ziolkowsky.

Matsumura et al, Shoji et al, and Ikekawa et al teach the claimed compounds as old and well known in combination with various pharmaceutical carriers and excipients in a dosage form. This medicament is taught as useful for treating various etiological agents, to include those recited herein. Claims 3 and 9, and the primary references, differ as to:

- 1) the employment of these medicaments dermally or cosmetically, and
- 2) administration levels of the medicaments.

Ziolkowsky teaches the claimed compounds as useful for a dermal, cosmetic use. Possessing this teaching, the skilled artisan would have been motivated to employ the claimed compounds for the dermal, or cosmetic use herein claimed and enjoy a reasonable expectations of therapeutic success.

Determining the active ingredient dosage level required to effect optimal therapeutic benefit is well within the Skilled Artisan's purview and the benefits of achieving such maximization obvious, to said skilled artisan. The claims merely recite the obvious employment of old and well known active ingredients, carriers and

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excipients. Thus, the only issue presented in the instant application is the obviousness of the claimed therapeutic methods.

Claim 9 specifically requires dermal pharmaceutical composition or cosmetic composition. Ziolkowsky employed the claimed compound in an dermal and cosmetic form, not specifically reciting another formulation. The skilled artisan would have seen dermal pharmaceutical composition or cosmetic compositions, and the administration of these compounds by these conventional means as residing in the skilled artisan purview.

RESPONSE TO ARGUMENTS

Examiner apologizes for the inadvertent failure to supply a signed 1449 submitted with paper 6. Additionally, Examiner apologizes for the inadvertent inclusion of a form paragraph averring a rejection under 35 USC 112, first paragraph. Examiner assumes this form paragraph was added due to a failure by the software employed by the Patent and Trademark Office. A rejection under 35 USC 112, first paragraph was not presented by Examiner.

Rebuttal arguments regarding the rejection under 35 USC 103 are not convincing. Examiner cited prior art teachings the instant therapeutic agents as broadly biocidal, to include those etiological agents herein claimed. Additionally, the

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skilled artisan would expect these agents to be useful for any biocidal use to include dermal, hair, or nails as herein claimed, absent contraindications. In the instant case this motivation need not be reached by the skilled artisan. Attention is directed to Ziolkowsky, teaching the claimed compounds as useful for treating hair, thereby rendering obvious the instant use of these compounds for treating hair, or scalp. A teaching of hair treatment with the claimed active ingredients teaches employing the claimed methods for the use herein intended. Absent contraindications, the skilled artisan possessing the Ziolkowsky teaching, would employ the recited compounds as herein claimed and enjoy a reasonable expectation of therapeutic success.

As stated above, determining the active ingredient dosage level required to effect optimal therapeutic benefit is well within the Skilled Artisan's purview and the benefits of achieving such maximization obvious, to said skilled artisan. The claims merely recite the obvious employment of old and well known active ingredients, carriers and excipients. Thus, the only issue presented in the instant application is the obviousness of the claimed therapeutic methods.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

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A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Russell Travers at telephone number (703) 308-4603.

A handwritten signature in black ink, appearing to be 'RT' or similar initials, with a long horizontal line extending to the right.

**Russell Travers
Primary Examiner
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